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31. (New) The apparatus of claim 29, wherein the gripping elements are radially expandable with pressurized hydraulic or pneumatic fluid.

32. (New) The apparatus of claim 29, wherein the gripping elements are radially expanded to engage an inner surface of a tubular.

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33. (New) The apparatus of claim 32, further comprising one or more compensating pistons, wherein the pistons are pneumatically operable and adjustable to compensate for different weights of the tubular.

34. (New) The apparatus of claim 29, wherein the body is connected to the top drive.

35. (New) The apparatus of claim 34, wherein the top drive provides rotational torque to permit a screw connection between one or more tubulars.

REMARKS

This is intended as a full and complete response to the Office Action dated March 29, 2001, having a shortened statutory extended one month to expire on July 30, 2001. Claims 1-24 are pending in the application and stand rejected. Applicants have canceled claims 17-25 to pursue in a divisional application. Applicants have also amended claims 1-16 to correct matters of form and to more clearly recite aspects of the invention. Applicants have further added new claims 26-35 to recite additional aspects of the invention. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1, 3-9 and 14-16 stand rejected under 35 U.S.C. § 102(a) as being anticipated by *Gjebedo* (WO 98/11322). Applicants have amended claims 1 and 15 to obviate the rejection and to more clearly recite the invention. *Gjebedo* discloses a device to interconnect pipes comprising an inflatable bellows clamped about a pipe member. The bellows is an elastic material such as rubber or plastic and is hydraulically inflated to engage an inner surface of a surrounding tubular. *Gjebedo*

teaches rotating the pipe member using a top drive, and then teaches using a separate moment tool to tighten the pipe member to a prescribed moment. Therefore, *Gjebedo* does not teach, show, or suggest an apparatus for facilitating the connection of tubulars using a top drive comprising at least one gripping element radially displaceable by hydraulic or pneumatic fluid to drivingly engage a tubular to permit a screw connection between said tubular and a further tubular to be tightened to a required torque, as recited in claims 1, 15, and those dependent therefrom. Accordingly, Applicants respectfully request withdrawal of the rejection.

Claims 2 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gjebedo* (WO 98/11322) in view of *Delano* (U.S. Pat. No. 4,100,968). The Examiner states that it would have been obvious to have included the spline recesses of *Delano* on the device of *Gjebedo* to have been able to easily detach and replace the device when necessary. The Examiner further states that it would have been obvious to have included the blade slips of *Delano* on the device of *Gjebedo* to have provided a more secure means for gripping the casing.

Applicants respectfully traverse the rejection on grounds that the Examiner has not established a *prima facie* case of obviousness. To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. See, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Further, the teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not in the applicants' disclosure. See M.P.E.P. § 2143, citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Still further, the examiner must *particularly* identify any suggestion, teaching or motivation from within the references to combine the references. See, *In Re Dembicza*k, 50 USPQ2d 1614 (Fed. Cir. 1999). The mere recitation of a combination of references does not amount to particularly identifying a suggestion, teaching, or a motivation to combine the references.

Here, the Examiner has simply combined two references to recreate the Applicant's claimed invention. The Examiner's reasons for combining the references are from the Applicants' own disclosure which is impermissible hindsight. Hindsight may not form the basis for an obviousness type rejection. Accordingly, Applicants

respectfully request withdrawal of the rejection.

Furthermore, Applicants respectfully traverse the rejection on grounds that a combination of the references does not expressly or impliedly teach, show, or suggest the claimed invention. *Gjebedo* has been distinguished above. *Delano* discloses a device consisting of a slip section, a tong section, and a seal section mechanism that are threadably inter-connected and rotated by a rotating device. *Delano* does not teach, show, or suggest a top drive comprising at least one gripping element radially displaceable by hydraulic or pneumatic fluid to drivingly engage a tubular to permit a screw connection between said tubular and a further tubular to be tightened to a required torque, as recited in claims 1. Therefore, a combination of the references does not teach, show, or suggest the claimed invention, and since claims 2 and 12 depend from claim 1, claims 2 and 12 are patentable over a combination of the references for at least the same reasons as claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection.

Claims 10, 11 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gjebedo* (WO 98/11322) in view of *Boyadejeff* (U.S. Pat. No. 4,605,077) and *Albright et al.* (U.S. Pat. No. 6,000,472). The Examiner states that it would have been obvious to have used the tubing support system of *Boyadejeff* in conjunction with the weight compensating pistons of *Albright et al.* with the pipe connecting device of *Gjebedo* to have been able to use the device with pipes of various lengths, thus weights, without overloading the system. The further Examiner states that it would have been obvious to have used the swivel system with bearings of *Boyadejeff* to support the device and casing of *Gjebedo* in order to have supported the tubing and allowed the tubing and device to rotate freely.

Applicants respectfully traverse the rejection on grounds that the Examiner has not established a *prima facie* case of obviousness. As stated above, a mere recitation of a combination of references does not amount to particularly identifying a suggestion, teaching, or a motivation to combine the references. Further, none of the references teach, show, or suggest a top drive comprising at least one gripping element radially displaceable by hydraulic or pneumatic fluid to drivingly engage a tubular to permit a screw connection between said tubular and a further tubular to be tightened to a

required torque, as recited in claims 1. Since claims 10, 11, and 13 depend from claim 1, the claims are patentable for at least the same reason as claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection.

Claims 17 and 22-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gjebedo* (WO 98/11322) in view of *Delano, Mullins* and *Littell*. Claims 18-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gjebedo* (WO 98/11322) in view of *Delano, Mullins* and *Littell* as applied to claim 17 above, and further in view of *Boyadejeff*.

Applicants have canceled claims 17-24. Accordingly, withdrawal of the rejection is respectfully requested.

The prior art made of record is noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the office action. Therefore, it is believed that a detailed discussion of the secondary references is not deemed necessary for a full and complete response to this office action. Accordingly, allowance of the claims is respectfully requested.

In conclusion, the references cited by the Examiner, neither alone nor in combination, teach, show, or suggest the claimed invention. Applicants further submit that new claims 26-35 are not taught, shown, or suggested by the prior art. Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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APPENDIX

1. (Amended) An apparatus for facilitating the connection of tubulars using a top drive, which apparatus comprises:

a body [(2; 102)] connectable to said top drive; and [, said body (2; 102) comprising]

at least one gripping element [(5; 105)] radially displaceable by hydraulic or pneumatic fluid to drivingly engage a tubular [(30; 110)] to permit a screw connection between said tubular and a further tubular to be tightened to [the] a required torque.

2. (Amended) The [An] apparatus as claimed in claim 1, wherein said [at least one] gripping element [(5; 105)] has an elastomeric gripping surface incorporating projecting metal inserts or saw blades [capable of transmitting said torque].

3. (Amended) The [An] apparatus as claimed in claim 1, wherein said [at least one] gripping element [(5; 105)] is movable radially outwardly from said body [(2; 102)] to engage [the] an inside wall [(31; 111)] of said tubular [(30; 110)].

4. (Amended) The [An] apparatus as claimed in claim 1, wherein said body [(2; 102)] is connectable to a rotor [(35)] of said top drive in order to rotate said apparatus.

5. (Amended) The [An] apparatus as claimed in claim 1, further comprising a sealing packer [(107)] for engagement with said tubular.

6. (Amended) The [An] apparatus as claimed in claim 5, wherein said sealing packer [(107)] can be activated by the hydraulic or pneumatic fluid.

7. (Amended) The [An] apparatus as claimed in claim 1, wherein said body [(2; 102)] is provided with a passage [(3; 103)] therethrough to allow excess fluid in said tubular to escape therefrom.

9. (Amended) The [An] apparatus as claimed in claim 5, further comprising a [wherein said] support [(12)] is connectable to a stator of said top drive.

10. (Amended) The [An] apparatus as claimed in claim [8] 9, wherein said support [(12)] is carried by one or more compensating pistons [(26, 27)] connectable to said top drive.

11. (Amended) The [An] apparatus as claimed in claim 10, wherein said compensating pistons [(26 27)] are pneumatically operable and are adjustable to compensate for different weights of the tubular.

12. (Amended) The [An] apparatus as claimed claim 1, wherein an upper part of said body [(2)] comprises a splined recess into which a [splined rotor or] splined connecting member [(20)] may be located.

13. (Amended) The [An] apparatus as claimed in claim [8] 9, wherein said support [(12)] is [arranged circumjacent] disposed about an upper part of said body [(2)] having [with a] one or more bearings [(8, 9)] arranged therebetween to allow said body [(2)] to rotate with respect to said support[s (12)].

14. (Amended) The [An] apparatus as claimed in claim 1, further comprising a rotary transmission [(7)] to allow hydraulic or pneumatic fluid to pass through said body [(2; 102)].

15. (Amended) An apparatus for [facilitating the connection of] connecting tubulars using a top drive, [said apparatus] comprising:

 a body [(102)] connectable to said top drive; [, said body (102) comprising]
 at least one gripping element [(105)] radially displaceable to drivingly engage a tubular to permit a screw connection between said tubular and a further tubular to be tightened to a required torque; [(110)] and
 a sealing packer [(107)] to inhibit, in use, fluid in said tubular from escaping therefrom.

16. (Amended) The [An] apparatus as claimed in claim 15, wherein said sealing packer can be actuated by hydraulic or pneumatic fluid.